

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

SETTE *et al.*

Appl. No.: 10/677,754

Filed: October 3, 2003

For: **Optimized Multi-Epitope
Constructs and Uses Thereof**

Confirmation No.: 5542

Art Unit: 1648

Examiner: Nicole Kinsey

Atty. Docket: 2473.0200003/EKS/PAC

Reply to Restriction Requirement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated March 15, 2007, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elects to prosecute the invention of Group **I**, represented by claims 1, 4, and 5. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with traverse** with respect to the restriction of claims in groups **III** and **V**.

The Examiner asserts that Group **I**, represented by claims 1, 4 and 5, and Groups **III** and **V** as represented by claims 6 and 7, respectively, are distinct inventions. The Examiner alleges that the inventions are distinct because the product as claimed can be used in a materially different process of using that product, for example, an immune response can be induced by administering an HBV polypeptide, citing M.P.E.P. §806.05(h). The Examiner has asserted therefore, that searching the inventions would

impose a serious search burden because the groups have acquired a separate status in the art. Applicants traverse for at least the following reason.

"If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." M.P.E.P. §803. Applicants respectfully submit that the Examiner has not demonstrated that searching the subject matter of Group **I** would impose a serious burden over searching the subject matter of Groups **III** and **V**. Searching the art pertaining to the nucleic acids of Group **I** would lead the Examiner to references that disclose the process for using the polynucleotide to induce an immune response, as recited in Group **III**. It would also lead the Examiner to references that disclose the process for making the polynucleotides of Group **I**. Accordingly, it would not be an undue burden for the Examiner to search Groups **I**, **III** and **IV** together. Thus, in view of M.P.E.P. §803, Applicants respectfully request that all claims be searched and examined in the subject application. Therefore, reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

Request for Rejoinder

The Examiner has required restriction between product (Group **I**) and process of use claims (Groups **III** and **V**). In accordance with the decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F3d 1565, 37 USPQ2d 1663 (Fed. Cir. 1996), and the notice published in the Official Gazette on March 26, 1996, setting forth new guidelines for the treatment of restricted product and process claims (*see* 1184 O.G. 86), Applicants respectfully request that if the restriction

requirement is made final and if the claims of elected Group I (claims 1, 4 and 5) are found allowable, then the claims of Groups III (claim 6) and V (claim 7) be rejoined and examined for patentability. *See also* M.P.E.P. § 821.04.

In response to the Examiner's requirement for an election of species, Applicants further elect to prosecute the polynucleotide sequence of SEQ ID NO:207. This election is made without traverse.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

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